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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1952.

No. 709

FRANK ADAM ELECTRIC COMPANY,
Petitioner,

vs.

FEDERAL ELECTRIC PRODUCTS CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI

To the United States Court of Appeals for the Eighth Circuit.

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INDEX.

Page

Jurisdiction 2

Summary and short statement..... 2

Questions presented 4

Reasons relied on for the allowance of the writ..... 5

I.

The Court of Appeals, by its affirmance, has so far sanctioned a departure by the District Court from the accepted and usual concepts of "due process of law" and of "laches" as to call for an exercise of this Court's powers of supervision..... 5

II.

The Court of Appeals has decided important questions of federal law in a manner which conflicts with the decisions of this Court (rendered some years ago, but never overruled), and in conflict with more recent decisions in other circuits..... 7

(a) Are claims carried over (unaltered) from the original patent into a reissue on an unaltered specification invalid because a statutory excuse for the reissue did not exist?... 7

(b) Is diligence in making application for reissue measured by different standards in cases where (as here) the reissue narrows the original claims than in cases where the reissue broadens the original claims?..... 8

III.

The lower Court has decided an important question of patent law which has not been, but should be, settled by this Court..... 10

Prayer 11

Cases Cited.

Altoona Theatres v. Tri-Ergon Corp., 294 U. S. 477..8, 10

Ball & Roller Bearing Co. v. Sanford Mfg. Co. (C. A. 2), 297 Fed. 163..... 9

Better Packages, Inc., v. Derby Sealers, 43 F. Supp. 123 9

Budd Wheel Co. v. General Motors Corp., 16 F. Supp. 115, 116 (Del.) 7

Cleveland Trust Co. v. Thomas, 1 F. Supp. 917, 920 (Mass.) 7

Dempster Bros. Brooks Equipment Mfg. Co., 78 USPQ 142 (Tenn.)..... 7

Ensten v. Simon Ascher & Co., 282 U. S. 445..... 8

Farmer's Bank etc. v. Halsey, Stuart & Co. (C. A. 3), 21 F. (2d) 818, 822..... 7

Fehr v. Activated Sludge (C. A. 7), 84 F. (2d) 948.. 9

Florence-Mayo Co. v. Hardy (C. A. 4), 168 F. (2d) 778 9

Florence-Mayo Co. v. Nuway (C. A. 4), 168 F. (2d) 778, 783 7

Foxboro Co. v. Taylor Instrument Co., 157 F. (2d) 226, 228 (cert. den., 329 U. S. 800)..... 7

Gage v. Herring, 107 U. S. 640, 646..... 8

Galliher v. Caldwell, 145 U. S. 368..... 6

General Radio Co. v. Allen B. Du Mont Labs., 129 F. (2d) 608 9

Gypsy Oil Co. v. Escoe, 275 U. S. 498..... 2

Holmberg v. Armbrect, 327 U. S. 392, 396..... 6

In re Stillwell (C. A. 2), 120 F. (2d) 194, 195..... 6-7

Kansas City etc. Co. v. Cox (C. A. 6), 104 F. (2d) 321, 325 7

Liggett v. Standard Oil Co., 149 U. S. 287, 293..... 8

Mahn v. Harwood, 112 U. S. 354 8
Milcor v. Fuller, 316 U. S. 143 8
Miller v. Brass Co., 104 U. S. 350 8

Pfister v. Northern Illinois Finance Corp., 317 U. S. 144 2

Rothholz v. Kreger, 89 F. Supp. 231, 233 (Conn.) 7

Shaffer v. Rector etc. Co. (C. A. 5), 155 F. (2d) 344, 346 7
Southern Pacific Co. v. Bogert, 250 U. S. 483, 488-90 .. 6, 10
Standard etc. Co. v. Ditto, Inc. (C. A. 1), 100 F. (2d) 466, 469 9
Stauck v. Bendix Corp., 26 F. Supp. 901, 903 (Ind.) .. 7

Topliff v. Topliff et al., 145 U. S. 156 9

United Autographic Register Co. v. Trindl, Inc., 38 U. S. P. Q. 522 (no Federal citation) 11
Universal Coin Lock Co. v. American etc. Co. (C. A. 7), 104 F. (2d) 781, 782 7

Van Kannel etc. Co. v. Winton Hotel Co. (C. A. 6), 276 Fed. 234, 239 10

Wire Tie Mach. Co. v. Pacific Box Corp. (C. A. 9), 102 F. (2d) 543, 559 9

Yale v. Sargent, 117 U. S. 536 8

Statutes Cited.

R. S. 4916 4
Secs. 251 and 252 of Title 35, U. S. Code 4
28 U. S. Code, Sec. 1254 (1) 2
35 U. S. Code, Sec. 64 4

Miscellaneous Cited.

Rule 8 (c) of the Rules of Civil Procedure 5

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PETITION FOR WRIT OF CERTIORARI

To the United States Court of Appeals for the Eighth Circuit.

To the Honorable, The Chief Justice, and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Frank Adam Electric Company, respectfully prays for writ of certiorari to the United States Court of Appeals for the Eighth Circuit to review the judgment of that Court entered December 9, 1952.

The opinion of the Court of Appeals (R. 233)[1] is reported at 200 F. (2d) 210. The opinion of the District Court (R. 54) is unreported.

[1] The Record pages indicated herein appear in red in the lower corners of the pages comprising the consolidated record as certified from the Court of Appeals.

JURISDICTION.

The jurisdiction of this Court is invoked under 28 U. S. Code, § 1254 (1). After the judgment of December 9, 1952, timely petition for rehearing (R. 241) was filed on December 24, 1952, and was denied on January 14, 1953. Time for filing this petition runs from the latter date (Gypsy Oil Co. v. Escoe, 275 U. S. 498; Pfister v. Northern Illinois Finance Corp., 317 U. S. 144).

SUMMARY AND SHORT STATEMENT.

Petitioner sued (R. 9) Respondent for infringement of Reissue patent No. 22,266 (R. 37). On motion for summary judgment (R. 11) the District Court held the patent invalid *in toto*, but founded its judgment (R. 45) on three grounds, **none** of which was stated in the motion for summary judgment. The Court of Appeals affirmed (R. 239).

There is no dispute of fact. The controversy concerns the legal effect of these admitted facts:

1. Petitioner's original patent No. 2,186,813 (R. 13) was granted January 9, 1940. Four of its claims (Nos. 13, 14, 18 and 19) were broader than the patentees were entitled to (but they did not then know it).

2. Thereafter the four unduly broad claims became involved in an interference. They were copied into a pending application which later matured into Patent No. 2,289,122 (R. 195).

3. On October 24, 1941, Petitioner signed two instruments designed to cure the undue breadth of the four claims, and to terminate the interference.

   a. A concession of priority (R. 32).

   b. A disclaimer (R. 33).

4. On October 29, 1941, judgment, adverse to Petitioner, was entered in the interference (R. 82-84). The adverse award of priority and the disclaimer were published in the Official Gazette on November 18 and 25, 1941 (532 OG 509 and 775).

5. On April 27, 1942, this Court decided Milcor v. Fuller, 316 U. S. 143, resolving a conflict of law[2] with respect to disclaimers of the type which had been filed by Petitioner six months previously. This Court then admonished:

> "If an alteration of one of the essential elements of a claimed combination were permissible at all, it would be under the reissue statute, Rev. Stat., § 4916, 35 U. S. C., § 64, which grants rights only from the date of reissue and after consideration by the patent office."

6. On July 9, 1942, Petitioner filed its application for reissue. The reissue patent (R. 37) was granted February 16, 1943, with claims 1 to 12, inclusive, 15, 16 and 17 of the original patent carried over without change, and claims 13, 14, 18 and 19 rewritten to include the interpretative restrictions of the disclaimer.[3] The specification remained the same.

Both the Court of Appeals and the District Court held Petitioner's reissue patent invalid *in toto* on the ground of laches (which was not raised by the motion). In addition the Court of Appeals held the patent invalid for "failure to prove that the error sought to be corrected by the reissue patent had 'arisen by inadvertence, accident,

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2 "We granted certiorari because of alleged conflict with decisions on the question in other circuits" (316 U. S., l. c. 144).

3 There has never been any dispute about the verity that the claims were the same in scope after the reissue, as after the disclaimer.

> "Claims 13, 14, 18 and 19 of the reissue patent are the same as the claims of the same numbers in the original patent as they stood prior to the disclaimer but with the elements added by the disclaimer included in these claims of the reissue patent" (R. 85).

or mistake' " (R. 239) (a ground of the motion which the District Court had found it "unnecessary to decide" [R. 57]).

The statute,[4] in force at the time of Petitioner's application for reissue, made the reissue remedy available to correct any patent which is "wholly or partly—invalid—by reason of the patentee claiming as his own invention more than he had a right to claim as new, if the error has arisen by inadvertence, accident or mistake." In their application for reissue, Petitioner's patentees made oath (R. 35) that claims 13, 14, 18 and 19 of the original patent "were too broad in that they embraced subject matter of which deponents were not the first inventors" and that such error "arose from inadvertence, accident or mistake without any fraudulent or deceptive intention on their part." The reissue application thus corrected the same mistaken overclaiming which the disclaimer, filed eight months previously, was intended to correct. When, in the meantime, this Court decided the Milcor case, it became apparent that Petitioner had pursued the wrong remedy. The application for reissue was then promptly filed.

QUESTIONS PRESENTED.

1. In summary judgment proceedings is it due process of law for a court to adjudge a property right invalid for laches, when the pleadings did not raise the issue?

2. Where a reissue patent contains claims carried over (unaltered) from the original patent, and other claims which were altered, does the failure to prove a statutory (R. S. 4916) excuse for reissue render invalid claims which were unaltered by the reissue?

3. Where, in his original patent, a patentee has mistakenly claimed "as his own invention more than he had

[4] R. S. 4916; 35 U. S. Code, § 64. That statute section has now been superseded by §§ 251 and 252 of Title 35, U. S. Code.

a right to claim as new", does the filing of an improper disclaimer make the original mistake unavailing as a ground for reissue?

4. Where, upon learning about the mistake in its patent, the patentee, *instanter,* makes a disclaimer publicly proclaiming a restricted interpretation upon which he would stand; and where there was pending, at the time, in this Court a case which would resolve an existing conflict of law as to the propriety of a disclaimer in the circumstances; is it laches for the patentee to await the decision of this Court before filing an application for narrowing reissue (which would have been unnecessary had this Court reached the opposite conclusion)?

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

I.

The Court of Appeals, by its affirmance, has so far sanctioned a departure by the District Court from the accepted and usual concepts of "due process of law" and of "laches" as to call for an exercise of this Court's powers of supervision.

To adjudge a patent invalid on the ground of "laches" without previous affirmative pleading deprives the patent owner of his property without due process of law. As concerns "laches," the due process is established by Rule 8 (c) of the Rules of Civil Procedure, thus:

> "c. **Affirmative Defenses.** In pleading to a preceding pleading, a party shall set forth affirmatively—laches—and any other matter constituting an avoidance or affirmative defense."

The lower Courts have, in effect, held that the "due process" thus prescribed by Rule 8 (c) does not apply to

a motion for summary judgment. While the summary judgment rule (56) does not, in so many words, say that such a motion must specify all the grounds or reasons upon which it depends, such is implicit in the rule. The contrary notion is not only without precedent but is as foreign to our system of jurisprudence as the idea of convicting a citizen of one crime on an indictment charging another. Here we have the spectacle of the District Court, *sua sponte*, raising the question of laches, deciding it, and adjudging the patent wholly invalid on that ground without affording Petitioner any opportunity to adduce evidence on the question.

The holding of laches itself, on the facts shown by the record, is an unprecedented departure from the accepted and usual standards. The Court of Appeals says (R. 236):

> "The delay in filing the application for reissue was about eight months after the appellant learned about the mistake in its patent."

Even if there was a "delay" of "about eight months" there is no suggestion in the record that any member of the public (Respondent did not even exist at the time) was in anywise affected by that "delay." Nor is there anything in the record from which public injury can be implied. On the contrary, any possible injury to the public was foreclosed by the publication of Petitioner's disclaimer on November 25, 1941, **seven and a half months** before the application for reissue was filed on July 9, 1942. Absent some showing from which it can be deduced that the "delay" prejudiced the defendant or the public, it has been consistently held by this Court (and by the Courts of Appeals for the Second, Third, Fourth, Fifth, Sixth and Seventh Circuits) that laches is not established by lapse of time [Holmberg v. Armbrect, 327 U. S. 392, 396; Southern Pacific Co. v. Bogert, 250 U. S. 483, 488-90; Galliher v. Caldwell, 145 U. S. 368; In re Stillwell (C. A. 2), 120 F.

(2d) 194, 195; Farmer's Bank etc. v. Halsey, Stuart & Co. (C. A. 3), 21 F. (2d) 818, 822; Florence-Mayo Co. v. Nuway (C. A. 4), 168 F. (2d) 778, 783; Shaffer v. Rector etc. Co. (C. A. 5), 155 F. (2d) 344, 346; Kansas City etc. Co. v. Cox (C. A. 6), 104 F. (2d) 321, 325; Universal Coin Lock Co. v. American etc. Co. (C. A. 7), 104 F. (2d) 781, 782].

II.

The Court of Appeals has decided important questions of federal law in a manner which conflicts with the decisions of this Court (rendered some years ago, but never overruled), and in conflict with more recent decisions in other circuits.

(a) **Are claims carried over (unaltered) from the original patent into a reissue on an unaltered specification invalid because a statutory (R. S. 4816) excuse for the reissue did not exist?**

By its affirmance of the judgment holding Petitioner's reissue patent invalid *in toto*,[5] the Eighth Circuit Court of Appeals has decided the above-stated question in a manner which clearly conflicts with recent decisions of the Court of Appeals for the Second Circuit[6] and District Courts[7] in the First, Second, Third, Sixth, and Seventh Circuits. These last-mentioned decisions are all based upon this

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5 The reissue patent in suit contains claims 1 to 12, inclusive, 15, 16, and 17, which were unchanged by the reissue.

6 Foxboro Co. v. Taylor Instrument Co., 157 F. (2d) 226, 228 (cert. den., 329 U. S. 800):

> ". . . As to these (claims carried over from the original patent) we need not consider whether Mason showed adequate excuse for any reissue whatever, because, even though he did not, the surrender of the original patent, resulting from the acceptance of the reissue, did not invalidate any claims which he carried over into the reissue."

7 Cleveland Trust Co. v. Thomas, 1 F. Supp. 917, 920 (Mass.); Rothholz v. Kreger, 89 F. Supp. 231, 233 (Conn.); Budd Wheel Co. v. General Motors Corp., 16 F. Supp. 115, 116 (Del.); Dempster Bros. v. Brooks Equipment Mfg. Co., 78 USPQ 142 (Tenn.); Stauck v. Bendix Corp., 26 F. Supp. 901, 903 (Ind.).

Court's early rulings in Gage v. Herring, 107 U. S. 640, 646; Mahn v. Harwood, 112 U. S. 354; Yale v. Sargent, 117 U. S. 536; or Liggett v. Standard Oil Co., 149 U. S. 287, 293.

This Court has not considered the question for sixty years. Now that conflict exists, it is important not only to reissue patentees but to all members of the public who are concerned with patents, to know whether a defect in the reissue proceedings invalidates the reissue patent *in toto* (as the Court below has held) or merely as to the claims added by the reissue (as this Court repeatedly held before the turn of the century). Note that, in Altoona Theatres v. Tri-Ergon Corp., 294 U. S. 477, this Court held it "unnecessary to determine whether the improper disclaimers[8] as to some claims render the entire patent invalid" (l. c. 493); and likewise in Milcor v. Fuller, 316 U. S. 143, the Court passed only on the claims which were affected by the improper disclaimer. The present case squarely presents the question of whether claims which were wholly untouched by either the disclaimer or the reissue are invalid because of a defect in the corrective proceedings.

(b) **Is diligence in making application for reissue measured by different standards in cases where (as here) the reissue narrows the original claims than in cases where the reissue broadens the original claims?**

In dealing with a **narrowing** reissue in this case, the Court of Appeals has held for naught the distinction recognized by this Court in Miller v. Brass Co., 104 U. S. 350:

> "The correction of a patent by means of a reissue where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended

8 **Improper** disclaimer is to be distinguished from unreasonably delayed disclaimer. The latter had previously been held to invalidate the whole patent in Ensten v. Simon Ascher & Co., 282 U. S. 445.

with such injurious results as follow from the enlargement of the claim. And hence a reissue may be proper in such cases, though a longer period has elapsed since the issue of the original patent. But in reference to reissues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied; . . ." (loc. cit. 355-356.)

and in Topliff v. Topliff et al., 145 U. S. 156 (speaking of the Miller v. Brass Co. case):

". . . It was held that while **lapses of time might be of small consequence where the original claim was too broad**, and the patentee sought to restrict it, there were substantial reasons why the claim could not be enlarged unless the patentee used due diligence to ascertain his mistake." (loc. cit. 168.) (Emphasis ours.)

The Courts of Appeal for the First, Second, Fourth, Seventh, and Ninth Circuits consistently recognize that diligence should be measured by different standards depending upon whether the reissue narrows or broadens the original claim [Standard etc. Co. v. Ditto, Inc. (C. A. 1), 100 F. (2d) 466, 469; Ball & Roller Bearing Co. v. Sanford Mfg. Co. (C. A. 2), 297 Fed. 163; Florence-Mayo Co. v. Hardy (C. A. 4), 168 F. (2d) 778; Fehr v. Activated Sludge (C. A. 7), 84 F. (2d) 948; Wire Tie Mach. Co. v. Pacific Box Corp. (C. A. 9), 102 F. (2d) 543, 559]. The Third Circuit (General Radio Co. v. Allen B. Du Mont Labs., 129 F. [2d] 608), has expressly denied the distinction, and now the Eighth Circuit has implicitly done so.

In no previous case (which we have found) has a delay as short as eight months been held fatal to an application for **narrowing** reissue. The shortest previously reported time period for such is two and a half years after the patentee had knowledge of a judicial determination of invalidity (Better Packages, Inc., v. Derby Sealers, 43 F. Supp. 123). On the contrary, a delay of nearly ten months

was held not fatal in Van Kannel, etc., Co. v. Winton Hotel Co. (C. A. 6), 276 Fed. 234, 239. In the latter case, the patentee presented an unsigned application for reissue (which was not accepted for filing, and hence the public had no notice of it) within two months after the adverse judgment; whereas in this case the patentee's disclaimer was made a matter of public record two days after the adverse judgment. Whether Petitioner's disclaimer[9] was good or bad, its filing precluded the possibility that any member of the public would misapprehend Petitioner's position.

It is important that this Court settle the question of whether the distinction between broadened and narrowed reissues, as recognized in its earlier decisions, still obtains.

III.

The lower Court has decided an important question of patent law which has not been, but should be, settled by this Court.

This case squarely presents the question of whether the filing of an improper disclaimer (designed to cure a mistake in the original patent) makes the original mistake unavailing as a ground for reissue. This Court has never considered the question.

The decision of the Eighth Circuit Court of Appeals has the effect of striking down every patent wherein the patentee has sought to correct mistaken overclaiming of the invention, first by disclaimer and later by reissue. Petitioner's patent is not alone in this category. Such was done in the case of the patent involved in the case of Altoona Theatres v. Tri-Ergon Corp., 294 U. S. 477, where

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[9] Compare Southern Pac. Co. v. Bogert, 250 U. S. 483:

"Nor does failure, long continued, to discover the appropriate remedy, though well known, establish laches where there has been due diligence, and . . . the defendant was not prejudiced by the delay."

the reissue was applied for and obtained after this Court held the disclaimer improper. Such was done in the case of the patent involved in United Autographic Register Co. v. Trindl, Inc., 38 U. S. P. Q. 522 (no Federal citation), where the District Court for the Northern District of Illinois held the reissue valid. Such was also done in the case of Reissue Patent No. 21,507. Unquestionably there are others in the same boat.

PRAYER.

Wherefore, your Petitioner respectfully prays that writ of certiorari be issued to the United States Court of Appeals for the Eighth Circuit to the end that this cause may be reviewed and determined by this Court; that the decree of the lower courts dismissing Petitioner's complaint be reversed; and that the cause be remanded for trial.

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